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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant : Behler et al.
Appl. No. : 09/463,675
Filed : 05/12/00
Title : LOW VISCOSITY DISPERSION FOR PAPER OR TEXTILE
PROCESSING

Grp./A.U. : 1751
Examiner : J. Hardee

Docket No. : H 3033 PCT/US

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Marlene Capreri
Signature of certifier

Marlene Capreri
Typed or printed name of certifier

APPEAL BRIEF TRANSMITTAL

Commissioner for Patents
Washington, DC 20231

Sir:

Appellants' brief, in triplicate, is transmitted herewith in accordance with 37 CFR 1.192.

Please charge the required fee of \$320.00 to our Deposit Account No. 50-1177. This
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Respectfully submitted,

Cognis Corporation
2500 Renaissance Blvd., St. 200
Gulph Mills, PA 19406

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Washington, DC 20231

BRIEF ON APPEAL UNDER 37 C.F.R. 1.192

Sir:

REAL PARTY IN INTEREST

The real party in interest is Cognis Corporation, 2500 Renaissance Blvd., St.
200, Gulph Mills, PA 19406.

RELATED APPEALS AND INTERFERENCES

None.

Appl. No.: 09/463,675
Grp./A.U.: 1751

STATUS OF CLAIMS

Claims 15-22 are the subject of this appeal.

STATUS OF AMENDMENTS

Amendments were made, and entered, after final rejection.

SUMMARY OF THE INVENTION

Briefly stated, the present invention is directed to a concentrated, low-viscosity aqueous dispersion used for softening paper and textiles which contains a nonionic softener component selected from the group consisting of monoesters or diesters of glycerol with a C₈₋₂₂ fatty acid, including mixtures thereof, a polyol compound, a cationic emulsifier, a nonionic emulsifier, and water, and wherein the nonionic softener component and polyol compound are employed in a ratio by weight of from about 2.5:1 to 1:2.5. See page 2, lines 11 to 20.

ISSUES

Whether claims 15-22 are obvious under 35 U.S.C. § 103(a) over Weinelt et al., US 5,880,086.

Whether claims 21 and 22 are obvious under 35 U.S.C. § 103(a) over Weinelt et al., US 5,880,086 in view of Severns et al., US 5,531,910.

GROUPING OF THE CLAIMS

The claims stand and fall together.

ARGUMENT

Weinelt '086 fails to render the claimed invention obvious on the grounds that

Appl. No.: 09/463,675
Grp./A.U.: 1751

it fails to teach or suggest all of the claim limitations.

It is extremely well settled that in order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure [underline emphases added]. See, *Manual of Patent Examining Procedure*, Rev. 3, July 1997, § 2142, pages 2100-108.

In view of the above, Appellant respectfully submits that the '086 reference fails to render the claimed invention *prima facie* obvious on the grounds that it fails to teach or suggest all of the claim limitations. More particularly, the presently claimed invention **requires** that the claimed nonionic softening component and polyol compound be employed in a ratio by weight of from about 2.5:1 to 1:2.5. Appellant respectfully submits that nowhere within the four corners of the Weinelt reference is it either taught or suggested to employ these two claimed components in this claimed ratio by weight.

More particularly, the Weinelt reference clearly teaches the use of both a nonionic surfactant and a polyol compound as being merely optional. As a result, Appellant submits that one of ordinary skill in the art might either use a nonionic surfactant only, a polyol compound only, or neither a nonionic surfactant nor a polyol compound. Moreover, even if per chance the routineer would choose to employ both, there is no teaching or suggestion contained in this reference which might motivate the routineer to wish to employ both the nonionic surfactant and the polyol **in the claimed ratio by weight**. This point is further supported by the Examiner's realization in Paper No. 11, page 4, paragraph 7, that

Appl. No.: 09/463,675
Grp./A.U.: 1751

examples 4 and 5 are described as being "low-viscosity" **in the absence** of both a nonionic surfactant and a polyol being used **in the claimed ratio by weight**. In view of this teaching, one of ordinary skill in the art, wishing to formulate a low viscosity laundry softening composition per the disclosure of the Weinelt reference would clearly **NOT** be motivated to modify its teachings in a manner which would read on the claimed invention since a low-viscosity formulation is already described in examples 4 and 5, **without the need for modification**.

The Examiner stated in Paper No. 13, page 3, that while the Weinelt reference admittedly does not teach Appellant's claimed weight ratio, by following the teachings of the reference, the routineer **could** make compositions which do meet this ratio. In response thereto, Appellant would like to note that it has been held that that which is within the capabilities of one skilled in the art is not synonymous with obviousness. See, Ex parte Gerlach, 212 USPQ 471 (Bd. Pat. App. & Inter. 1980). Moreover, it is well settled in the law that the mere allegation that the differences between the claimed subject matter and the prior art are obvious does not create a presumption of unpatentability which forces an Applicant to prove conclusively that the Patent Office is wrong. See, In re Soli, 137 USPQ 797 (CCPA 1963). The ultimate legal conclusion of obviousness must be based on facts or records, not on the Examiner's unsupported allegation that a particular modification is known and therefore obvious. Subjective opinions are of little weight in determining obviousness. see, In re Wagner et al, 152 USPQ 552 (CCPA 1967).

As a result, since the Weinelt reference fails to contain any concrete teaching or suggestion relating to the use of the claimed nonionic softening component and polyol compound in the claimed ratio by weight, this reference should not serve to render the claimed invention prima facie obvious.

Neither the Weinelt '086 nor the Severns et al '910 reference, alone or in

Appl. No.: 09/463,675
Grp./A.U.: 1751

combination, contains the requisite teaching or suggestion to render claims 21 and 22 of the present invention prima facie obvious.

The shortcomings associated with the disclosure of the Weinelt reference are as outlined above. More particularly, it is Appellant's position that low-viscosity formulations, **such as those noted by the Examiner (examples 4 and 5)** can be obtained without modifying the Weinelt composition in any way. Consequently, there is no reason for the routineer to employ Appellant's claimed combination of nonionic component and polyol compound in the **claimed ratio by weight**.

As for the Severns reference, it is relied upon merely for its teaching regarding the use of glycerol. However, in view of the above-described shortcomings associated with the Weinelt reference concerning the use of the claimed combination of nonionic component and polyol compound in the **claimed ratio by weight**, Appellant fails to see why one of ordinary skill in the art would wish to employ two admittedly unnecessary components which will increase the costs associated with formulating the Weinelt composition, and then unduly experiment with **numerous** potential weight ratio combinations in an effort to make a low viscosity composition in accordance with the claimed invention when a low viscosity composition can be formulated, based on examples 4 and 5 of the reference, without going through such unnecessary gyrations.

SUMMARY

Weinelt '086 fails to teach or suggest all of the claim limitations and, as a result, should not serve to render the claimed invention prima facie obvious.

Both Weinelt '086 and Severns '910 fail to teach or suggest all of the claim limitations and, as a result, should not serve to render the claimed invention prima facie obvious.

It is requested for the reasons given above, that the Board find for Appellant on all

Appl. No.: 09/463,675
Grp./A.U.: 1751

of the issues, and reverse the Examiner's Final Rejections.

Respectfully submitted,



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APPENDIX

CLAIMS ON APPEAL

15. A composition for softening paper and textile substrates comprising:
- (a) a nonionic component selected from the group consisting of a monoester of glycerol and a C₈₋₂₂ fatty acid, a diester of glycerol and a C₈₋₂₂ fatty acid, and mixtures thereof;
 - (b) a polyol component;
 - (c) a cationic emulsifier;
 - (d) a nonionic emulsifier; and
 - (e) water, and wherein the nonionic component and polyol component are present in the composition in a ratio by weight of from 2.5:1 to 1:2.5.
16. The composition of claim 15 wherein the composition has a Brookfield viscosity of from 1 to 100 mPas.
17. The composition of claim 15 wherein the nonionic component is present in the composition in an amount of from 1 to 14% by weight, based on the weight of the composition.
18. The composition of claim 15 wherein the nonionic component and the polyol component are present in the composition in a ratio by weight of from 2.0:1 to 1:1.
19. The composition of claim 15 wherein the polyol component is present in the composition in an amount of from 1 to 12% by weight, based on the weight of the composition.
20. The composition of claim 15 wherein at least 90% of particles present in the composition are smaller than 1000 nm.
21. The composition of claim 15 wherein the polyol component is a mixture of glycerol and polyethylene glycol.

Appl. No.: 09/463,675
Grp./A.U.: 1751

22. The composition of claim 21 wherein the glycerol and polyethylene glycol are present in a ratio by weight of from 10:1 to 6:1.